



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,663	10/17/2001	Masato Nogawa	30033.0004	7649

7590 01/12/2006

Michael F. Scalise  
Hodgson Russ LLP  
Suite 2000  
One M&T Plaza  
Buffalo, NY 14203-2391

EXAMINER

PETERSON, KENNETH E

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/982,663

Applicant(s)

NOGAWA ET AL.

Examiner

Kenneth E. Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-14 and 16-56 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 18-54 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-13 is/are allowed.
- 6) ☒ Claim(s) 16, 17, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2 Jan 04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3724

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16, 17, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art, as set forth on pages 1-5 of Applicant's specification, and in Applicant's figures 9 and 10. The admitted prior art discloses all of the recited features except that the booklet bundle height is inputted by the operator to control the pressing plate (18) height, instead of being automatically inputted by a first measuring means.

Examiner has taken Official Notice that it is well known to control the pressing plate height based upon sensors that measure the height of the incoming work to be pressed. Since Applicant has not challenged this taking of Official Notice, it is now taken to be fact as per 2144.03. An example of such is the patent to Sebelist et al.'542, which teaches height sensors (54) that in turn control the height of the pressing plate (14), as set forth on lines 30-37 of column 2. It would have been obvious to one of ordinary skill in the art to have modified Applicant's admitted prior art by adding a height sensor to control the pressing plate height, as is old and well known and taught by Sebelist, in order to further automate the device, thus increasing operating speed and decreasing human requirements.

In regards to claim 56, the admitted prior art books are considered to be "counted" as per page 11 of Applicant's specification, since neither Applicant's

specification nor claims disclose any counting structure that is not shown by the admitted prior art. If it is interpreted that the specification somehow infers some structure that is not shown by the admitted prior art, then Examiner has taken Official Notice that it is old and well known to electro-mechanically count the items in a stacks based on stack thickness. Since Applicant has not challenged this taking of Official Notice, it is now taken to be fact as per 2144.03. For example, Examiner has seen coin counters that work this way. It would have been obvious to one of ordinary skill in the art to have modified the admitted prior art by replacing it's counting system with an electro-mechanical counting system based on stack height, as is well known, in order to alleviate the machine operator from having to perform this task.

3. Claims 9-13 are allowed.

4. Applicant's arguments have been fully considered.

Applicant's IDSs are now fully compliant.

Applicant Foreign Priority requirements have been met.

Applicant's arguments with regards to claims 9-13 were persuasive and the claims have been allowed. It is noted that Applicant remarked that claims 11-13, 16 and 17 were withdrawn, but they have been rejoined as per the final rejection mailed 22 June 05.

It is noted that Applicant did not provide any specific arguments as to why old claims 16 and 17 or why new claims 55 and 56 distinguished over the prior art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached Mon-Thurs, 7:30AM-5PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KP  
January 9, 2006



KENNETH E. PETERSON  
PRIMARY EXAMINER